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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,016	04/20/2001	Yukihiro Kiuchi	NE+99P237A	9360

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/830,016

Applicant(s)

KIUCHI ET AL.

Examiner

Robert Sellers

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 34-37, 45 and 46.
Claim(s) withdrawn from consideration: 26-33, 38, 44 and 47.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Robert Sellers
Primary Examiner
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1. The amendment after Final rejection filed February 7, 2006 has been denied entry. The newly added limitation requiring the composition to exhibit "excellent flame retardancy without any flame retardant material nor flame retardant auxiliary" in independent claim 34 does not indicate the parameters for an "excellent" flame retardancy. Furthermore, the specification on page 5, lines 12-14 describes the attainment of flame retardance without a flame retardant material but does not preclude a flame retardant auxiliary. It is not known what is considered to be a "flame retardant auxiliary."
2. Examples 13-17 of Table 4 on page 46 of the specification exhibit formulations with only phenolbiphenylaralkyl Epoxy resin 2 (page 22, lines 14-17). Examples 5-8 of Table 2 on page 44 show compositions merely containing tetraphenylethane Epoxy resin 3 (page 22, lines 18-20). The exemplification of solely individual epoxy resins does not enable the claimed mixture.
3. Examples 18-20 of Table 5 on page 47 demonstrates a single ratio of tetraphenylethane Epoxy resin 3 to phenolbiphenylaralkyl Epoxy resin 2 of 0.2:1 (i.e. 1:5). When a blend of tetraphenylethane epoxy resin and phenolbiphenylaralkyl epoxy resin is employed, the only supported ratio is 1:5. The recitation of mixtures of epoxy resins in general (page 18, lines 3-5) without any disclosed weight ratio does not substantiate the claimed mixture of specific types of epoxy resins at a broad weight ratio range.

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4. Japanese Patent No. 9-268219 (page 6, paragraphs 33 and 34) discloses the presence of other epoxy resins in an amount of from 0 to 70% by weight per phenolbiphenylaralkyl epoxy resin, or a weight ratio of other epoxy resin to phenolbiphenylaralkyl epoxy resin of from 0 to 70:30, or 2.3:1 which overlaps the claimed weight ratio of 1:5, or 0.2:1. Other epoxy resin include diglycidyl ethers of bisphenol A or F as well as novolak epoxy resins which contain multiple epoxy groups.

5. Japanese '219 (Derwent abstract, page 2) and Japanese Patent No. 57-38814 are both directed to the common utility of a sealant for an electronic material. Thus, Japanese '814 establishes the use of a tetraphenylene epoxy resin in the same environment as that of Japanese '219. The objective of Japanese '219 is to improve the water resistance and mechanical strength. According to Japanese '814 and Japanese Patent No. 58-150581, a tetraphenylene epoxy resin contributes enhanced heat distortion temperature which is not a criteria for Japanese '219, although a desirable property for semiconductor sealants according to Japanese '814. Accordingly, it would have been obvious to utilize the tetraphenylene epoxy resin of Japanese '814 and '581 as the other epoxy resin of Japanese '219 in order to improve the heat distortion temperature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

rs
2/10/2006



ROBERT E.L. SELLERS
PRIMARY EXAMINER